REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

Claims 1-17 are now pending in this application.

1. Rejection of Claims 1-11 and 13-16 Under 35 U.S.C. § 103(a) As Being Unpatentable Over Helms in View of Ottenstein

In section 1 of the Office Action, claims 1-11 and 13-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helms (U.S. Patent No. 5,952,992) in view of Ottenstein (U.S. Patent No. 5,270,818). Applicants respectfully submit, for the reasons that follow, that the Examiner has not established any motivation or suggestion to combine the teachings of Helms and Ottenstein.

The Examiner acknowledged that "[a]lthough Helms discloses providing at least one photodetector on the front surface of the LCD, detecting ambient light at this front surface and providing input to computing electronics, Helms does not explicitly disclose at least two photodetectors." The Examiner further stated, however, that "Ottenstein [] discloses [a] bezel of [a] display comprising two ambient light sensors, positioned around the face of the display (see column 4, lines 65-66 and #12 and 13 of Figure 1, light represented by arrows points towards the sensors & face of the display)." The Examiner concluded that:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the automatic brightness control techniques of Helms with the multiple ambient light sensor configuration of Ottenstein in order to provide the computing electronics with a better representation of ambient light levels directed towards the surface of the display by supplying the electronics with multiple samples derived from the multiple sensors, thus the multiple samples provide more ambient light coverage at the display surface than only the single sensor of Helms.

In section 4 of the Office Action ("Response to Arguments") the Examiner further stated:

> Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection. Note, many of Applicant's arguments directed to the previous combination of Ottenstein in view of Helms are moot since the newly formed rejection, although still utilizing the same prior art, relies on a different interpretation and combination of the art. For example, Applicant has based much of the arguments [] upon the "teaching away" of Ottenstein from Helms because of Ottenstein indicating that his brightness control should not operate at low ambient light levels. This argument is moot since Helms is now the primary reference of the combination with the Office solely relying on Ottenstein for his configuration/location of ambient light sensors and not the above mentioned brightness control.

The Examiner seems to accept that there may be no motivation to combine Helms and Ottenstein when Ottenstein is used as the primary reference, and yet concludes that there is motivation to combine the references when Helms is used as the primary reference. Applicants respectfully disagree with this reasoning, and respectfully submit that this conclusion fails to consider Ottenstein and Helms in their entirety, including disclosure that teaches away from their combination. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). It is improper to combine references where the references teach away from their combination. See In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Viewed as a whole, the disclosure of Ottenstein specifically teaches away from a combination of Ottenstein with the teaching of Helms, regardless of which of the references is considered the primary reference. For example, Helms discloses that:

> [I]t is apparent that a user could significantly increase the runtime between battery changes ... by taking advantage of ambient light conditions that increase the visibility of the LCD, that is, low ambient light, and decreasing the brightness level of the LCD whenever the PC is being operated in such lighting conditions.

Col. 1, lines 43-49. Helms further states that "a technical advantage achieved with the invention is that it provides increased run time between battery changes by lowering the brightness level of an LCD during use in low ambient light conditions." Col. 2, lines 36-39. Thus Helms, when viewed as a whole, teaches the advantages of using its disclosed invention in low ambient light conditions to minimize power consumption and increase runtime between battery changes, and is specifically designed to take advantage of low ambient light conditions rather than to address bright ambient lighting conditions.

In contrast, Ottenstein teaches that "[t]he auto brightness control of the present invention is designed to automatically adjust brightness to maintain a constant contrast over changes in the reflected ambient light." Col. 3, lines 16-19. Ottenstein discloses that "the present invention ... provides compensation for the effects of sunlight in an avionics cockpit display." Col. 1, lines 40-41). Ottenstein specifically states further that "the automatic brightness control need not and should not operate at low ambient light levels, say less than 10% of maximum." Col. 3, line 68 – col. 4, line 2. Thus, Ottenstein is specifically designed to operate in an environment of and address the effects of bright ambient lighting conditions. While Helms specifically teaches the advantages of using its disclosed invention in low ambient light conditions, Ottenstein, viewed as a whole, specifically teaches away from such usage by stating to the contrary that its disclosed invention should not be used at low ambient light levels and placing limits on operation at a particular lighting level. Accordingly, Applicants respectfully submit that there is no motivation to combine the cited references.

Because the Examiner has not properly established motivation to combine the teachings of Ottenstein and Helms, the Examiner has failed to establish a proper prima facie case of obviousness. Without a proper motivation to combine the teachings of Ottenstein and Helms, it is apparent that hindsight reasoning has been used that relies on Appellants' own

disclosure as a roadmap. Accordingly, Applicants respectfully request that the rejection of claims 1-11 and 13-16 be withdrawn.

2. Rejection of Claims 12 and 17 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Helms in View of Ottenstein and Further in View of Katada.

In section 2 of the Office Action, claims 12 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helms in view of Ottenstein, and further in view of Katada (U.S. Patent No. 5,933,089). With regard to claims 12 and 17, Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness because there is no suggestion or motivation for one of ordinary skill in the art to modify Ottenstein or to otherwise combine the teachings of Ottenstein, Helms, and Katada to somehow arrive at the subject matter of claims 12 or 17. More specifically, there is no suggestion or motivation to combine the teachings of Ottenstein, Helms, and Katada because, viewed as a whole, the disclosure of Ottenstein specifically teaches away from a combination of Ottenstein with the teaching of Helms (as discussed above).

Thus, the combined teachings of Ottenstein, Helms, and Katada are not sufficient to render the subject matter of claim 12 or claim 17 prima facie obvious because there is no suggestion or motivation to combine the teachings of these references. See Manual of Patent Examining Procedure § 2143.01. Accordingly, Applicants request that the rejection of claims 12 and 17 under 35 U.S.C. § 103(a) be withdrawn.

3. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a

check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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